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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,938	08/02/2000	MICHEL LUSSIER	ADI-022	8689

21323 7590 10/30/2003

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EXAMINER

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ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/30/2003

256

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 26

Application Number: 09/630,938
Filing Date: August 02, 2000
Appellant(s): LUSSIER, MICHEL

Brian M. Gaff
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 30 2003
GROUP 3700

This is in response to the appeal brief filed 9/24/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 4-23, 26-31, and 35-39 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

✓ 4393604

CROWLEY

7-1983

✓ 5185943	TONG ET AL.	2-1993
✓ 1141889	TROLLE	6-1915
✓ 5546680 A	BARMA	8-1996
✓ 1684676	LORENZI ET AL	9-1928
✓ 5572805	GIESE ET AL	11-1996
✓ D446917	BROWN	8-2001
✓ 444735	THOMAS	1-1891
✓ 5713143	KENDALL	2-1998
✓ 3739497	CAMERON	6-1973
✓ 5473827	BARRE ET AL	12-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. Claims 26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Crowley (4393604).

Crowley shows an article of footwear comprising a chassis (formed by element 12) an outsole (formed by elements 110, 112, and 114 in combination with the chassis 12), and cleats (14, 18, 22, 28, etc. as shown in figures 1 and 2) as claimed.

2. Claims 1, 4-9, 19-21, 26-29, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tong (5185943).

Tong shows a "generally" planar chassis (120, figure 16) with elongate elements (122) in the forefoot area and elongate elements in the rearfoot area (see figure 16) and a cleat (either elements 34 or elements shown at number 24 in figure 1) as claimed.

In reference to claim 35, the encapsulating midsole material (see column 8 lines 36-40) is considered to be a "skin" as recited in the claims.

In reference to claim 39, the spaces between the elongate elements are curved and therefore are nonlinear as claimed.

Claim Rejections - 35 USC § 103

3. Claims 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trolle (1141889) in view of Barma (5546680).

Trolle shows a shoe comprising a chassis (A) which extends the entire length and width of the shoe sole and a lug (11 or 12) which extends from the bottom of the chassis for connection to a cleat (C or D) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Barma clearly teaches that it is known to use tough rigid plastics, i.e. polymeric materials, for protective plates/chassis (see column 3 lines 1-7 and lines 55-60) as an alternative to metals.

4. Claims 1, 4, 6-10, 19, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzi (1684676).

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Lorenzi shows a shoe with a chassis (4) with elongate elements (shown in figure 1) in the heel and forefoot areas, and a cleat (13) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of a chevron to make the opening easier to manufacture/cut.

5. Claims 1, 5, 6, 8-10, 12-23, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese (5572805) in view of Tong (5185943) or Brown (D446917) and Thomas (444735).

Giese (figures 111-116) shows a shoe sole with a chassis substantially as claimed except for the extent of the forefoot elements. Either Tong or Brown teaches extending forefoot elongated elements through the entire forefoot area (see figures 16 or figure 2). In reference to the exact orientation of Brown in a shoe, Thomas shows/teaches how such a shaped element would be placed in a shoe as one of ordinary skill in the art would have known to be inherent or at least obvious in the Brown reference due to the curved shape of the ends of the insert being the same as the known curved shape of conventional footwear. It would have been obvious to extend the forefoot elements as

taught and shown by either Tong or Brown in the shoe of Giese to provide support for the entire length of the foot.

In reference to claim 4, Tong specifically teaches and shows the use of three elongate forefoot elements (122). Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple elongate elements including three, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of chevron to make the opening easier to manufacture/cut.

In reference to claims 17 and 18, Giese teaches the well known use of different materials to provide different properties in different areas (column 13 lines 15-40). It would have been obvious to use different materials in different regions of the chassis of Giese as modified above to provide increased flexibility in areas which require such.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Kendall (5713143).

Giese as modified above shows a chassis substantially as claimed except for the opening being open to the side. Kendall teaches opening a heel area to the side in a chassis. It would have been obvious to provide a side opening as taught by Kendall in the chassis of Giese as modified above to increase flexibility and comfort in the heel.

7. Claims 26-30 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Crowley (4393604).

Giese as modified above shows a shoe substantially as claimed except for cleats on the sole. Giese suggests different contours for the outsole to increase traction of the sole (column 14 lines 20-23). Crowley teaches forming an outsole with molded cleats thereon as is well known. It would have been obvious to provide cleats as taught by Crowley on the outsole of Giese as modified above to increase traction.

In reference to claims 35-38, Giese as modified above shows a shoe sole with a skin layer (the bottom layer in figures 112-115), an intermediate film (shown in figures 112-115, which inherently has color), and a chassis (19). The use of transparent materials for the outser sole elements is extremely well known to allow an intereior element to be seen. It would have been obvious to make the outer skin layer transparent as is well known in the shoe of Giese as modified above to allow the interior elements to be seen.

8. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 26-30 and 35-38 above, and further in view of Cameron (3739497) or Barre (5473827).

Giese as modified above shows a shoe substantially as claimed except for providing a lug on the chassis which extends into the cleat. Cameron or Barre teaches providing lugs (32 or 23) on a chassis which extends into a cleat (24 or 11). It would have been obvious to provide lugs which extend into the cleat as taught by either Cameron or

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Barre in the shoe of Giese as modified above to increase stability and durability of the layered sole.

(11) Response to Argument

In response to applicants' argument that the elements shown by Crowley are not a "chassis", the outsole, and/or sole elements of Crowley can clearly be considered to be a chassis, i.e. a "frame" or "the assembled frame and parts" (as defined by Webster's New World Dictionary). Absent any further explicit claimed limitations the term "chassis" must be interpreted by the Examiner in the broadest reasonable manner. The prior art elements designated as a "chassis" in the rejection do not contradict any definition of the term "chassis" and therefore are considered to be a "chassis". There is no requirement in the claims that the outsole be a separate element, in fact the claims recite that the sole comprises the chassis. The claims do not define over an outsole being a chassis. Furthermore, elements 110, 112, and 114 could be considered a separate "outsole" attached to the bottom of the chassis (12). Crowley shows all of the positively recited and claimed structures in claims 26, 29, and 30.

In response to applicants' arguments directed towards the chassis of Tong not being "planar", it is noted that the claims recite that the chassis is "generally planar" and the chassis of Tong is considered to be "generally planar". Especially in view of applicants' figures 1B, 1C, 1D, 2B, 2C, 2D, 2F, 3B, 3C, 3D, and 3F which clearly show great variations in the planar aspect of the chassis, therefore if applicants chassis can be considered to be "generally planar", then the chassis of Tong is considered to be "generally planar".

In reference to claim 5, the elongate elements clearly have indentations along the width of the chassis, i.e. the indentations are shown at element 130 in figure 17 and extend along the width.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, all of the combined references are directed towards layered soles and elements embedded or layered in a sole to provide enhanced sole control, stiffening, strengthening, etc. .

In response to applicants' arguments that Trolle is an "outsole" not a chassis, Trolle clearly shows a "chassis" (A) inasmuch as applicant has defined and claimed such. It is noted that Trolle does have a separate outsole element formed by elements C and D or formed by elements 13 and 14). Also, it is noted that the claims do not require the "outsole" to be a separate element from the "chassis".

In response to applicants' argument that there is no lug projection in Trolle, Trolle clearly shows a lug projection (20 and/or 31). The fact that they only project slightly does not negate the fact that they are projections.

In response to applicants' argument that element 4 of Lorenzi is not a "chassis", element 4 of Lorenzi is considered to be a chassis inasmuch as applicant has claimed and defined such. As noted above the definition of a chassis is "a frame", element 4 of Lorenzi clearly is a "frame". Also, it is noted that applicants argues that the "chassis" is related to providing flexibility, and effective power transfer (page 24, third paragraph of the brief), the chassis (element 4 or Lorenzi) would clearly provide flexibility as shown in figure 5 and effect power transfer (due to the cleats being attached to the chassis).

Applicants' arguments directed towards such are not understood. It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OG 844) In response to Applicant's argument that the references do not address the same problems, the claims do not recite and such structure. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064.

In response to applicants' argument that Lorenzi has peripheral elements, not elongate elements, the elements which form the peripheral element clearly are shown as elongate elements which connect to one another at the toe and heel ends of the footwear. There is no language in the claims which preclude such a structure.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants' argument that the rejection/office action doesn't state what would have been obvious, the rejection/office action is explicitly clear as noted in paragraphs 8, 9, and 10 of the prior office action. It is not clear how such could be stated any clearer or more explicit.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

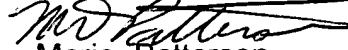
In response to applicants' arguments directed towards the references addressing a "different problem" and the citation of Lindemann Maschinenfabrik FMBH v. American

Hoist and Derrick Company et al 221 USPQ 481, it is noted that all of the applied references are directed towards shoe soles and address stiffness and stability problems. The case law cited is directed towards devices which are "entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently" (page 485 last line of decision-line 1 of page 486 of the decision under the section titled "I. Anticipation"). This clearly is not the same facts or situation as those in this application. The references are clearly directed towards shoe sole parts which operate to protect and support the foot of a wearer and which are intended to be worn by humans. It is noted that "the question of obviousness however is so closely tied to the facts of each particular case, that the prior decisions in cases involving different facts are ordinarily of little value in reaching a decision" (In re Lainson, 52 CCPA 880, 339 F2d 252, 144 USPQ 19 (1964)). Also, it is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OG 844) The law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims "read on" something disclosed in the reference, i.e. all limitations of the claim are found in the reference. (Kalman v. Kimberly Clark Corp. 713 F2d 760, 218 USPQ 871 (Fed Cir 1983))

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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MDP

October 28, 2003

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